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IN THE

Supreme Court of the United States

OCTOBER TERM, 1950

No. 341

FORREST H. SMITH ET AL., *Petitioners*

v.

FLORENCE-MAYO NUWAY COMPANY ET AL., *Respondents*

PETITIONERS' REPLY BRIEF.

CLARENCE M. FISHER,
W. BROWN MORTON,
Counsel for Petitioner.

New York, N. Y.,
November 15, 1950

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

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Respondent's brief follows the usual pattern of discussing issues which are not relied upon as reasons for granting the writ and ignoring those issues which are relied upon in an attempt to make it appear that the case presents no questions which would justify this Court in reviewing the decision of the Court of Appeals of the Fourth Circuit.

It is not contended by petitioners that the Courts in two different Circuits have rendered conflicting decisions with regard to the scope or validity of the patent here in suit, but that is no reason for denying this petition. In many, probably most of the patent cases which this Court in recent years has reviewed on certiorari there have been

no conflicting decisions with respect to the scope and validity of the particular patent in suit. In most of these cases the reason for granting the writ has been that in the decision reviewed, the lower Court has misconstrued or misapplied some rule of law of sufficient importance to justify an authoritative settlement of the question by a review by this Court.

This Court is also not entirely unmindful of the injustice to the litigant resulting from the failure of the lower Courts to follow the authoritative rulings of this Court, particularly where, as here, the lower Court has completely reversed its own previous decision on the same facts.

On page 3 of its brief respondent alleges that the decision of the Circuit Court of Appeals in the Mayo-Hardy case is not pertinent to the issue here under consideration. It is particularly pertinent here because the decision in this case is in direct conflct with the decision in that case. In the Mayo-Hardy case the Court found the successful curing of tobacco by the open flame system to be a notable achievement, and, being misled by the appellees here into believing that that success was due to the delivery of the conditioning air to the hoods of the burners to which the Mayo patent claims are directed, gave to the Mayo patent (by that Court's own statement in the opinion in this case) "the liberal treatment of a pioneer patent."

> "Since the Florence-Mayo Nuway Co. is a party to this suit, we think it not inappropriate to say that, in the light of the record here, the Mayo patent is not entitled to the liberal treatment of a pioneer patent, as indicated by our opinion in 168 F. 2d 778 . . ." (Appellees' App. 29)

The record here which disclosed to the Court of Appeals of the Fourth Circuit that they had been deceived by the evidence presented in the Mayo-Hardy case, establishes that Smith, and not Mayo, solved the problem of curing tobacco by the open flame system—that the problem was solved by what Mayo took from Smith and not by the air

pipe to the hood, as they had been led to believe. The status of pioneer which the Court of Appeals for the Fourth Circuit erroneously conferred upon Mayo should rightfully have been conferred upon Smith.

Respondents in their brief, on page 6, refer to the testimony of Moss and Mercer in support of its assertion that the Reynolds curer "had been quite widely used in actual practice and had operated successfully." This statement is directly contrary to the statements of the witnesses themselves. Moss was specifically asked whether or not the Reynolds device operated satisfactorily, and he said it did not.

> "Q. 20. What would you say, Mr. Moss, with reference to whether or not the Reynolds curing system of the type installed on the premises of the Experiment Station and to which you have referred was or was not a commercial success?
>
> A. 20. It was not satisfactory and therefore we never did use the second one. It was not a commercial success locally.
>
> Q. 21. Do you know of any other person who undertook to use or operate one?
>
> A. 21. I do not know positively. There was some of them used in the eastern part of the state—I do not know where.
>
> Q. 22. You do not know, do you, Mr. Moss, with what degree of success if any the people to whom you refer as being down east were able to operate the system?
>
> A. 22. Let's get that clear.
>
> Q. 23. You do not know with what degree of success, if any, the people you refer to as being down east experienced in their efforts to operate the system?
>
> A. 23. No sir." (Moss, Appellants App. 110-111)

Mercer stated that the quality of the tobacco was so impaired that he discarded the apparatus.

> Q. State whether or not, in your opinion, Mr. Mercer, the commercial value of the tobacco you undertook to cure in the barn with the Reynolds curer was less than if you had cured it in a barn equipped with the ordi-

nary flue and furnace system? A. I should say it was 25% damaged.

Q. You mean that it was worth 25% less? A. That is right, yes sir.

Q. Mr. Mercer, to your knowledge has anyone been able to successfully cure tobacco with the Reynolds curer such as you have described? A. Not as I ever heard tell of. Never have seen any more of them after that year. (Mercer, Appellants' App. 107)

Respondents' discussion on pages 9-12 of their brief, under the headings "Adjacent" and "Independent" demonstrate the extent to which the Court of Appeals of the Fourth Circuit read into the claims the details of the structure disclosed in the patent in suit in order to exclude from their scope the accused apparatus. Thus, respondents contend that "adjacent the walls" means all four walls of the barn, although the number of walls is not recited in the claims; also, that *all* of the burners of the series must be closely adjacent the barn wall, as shown in the patent drawing where the series of burners are *parallel* with the barn walls, although nothing is said in the claims as to whether the series of burners is parallel with or perpendicular to the barn walls.

Respondents contend that referring to the burners as "independent" limits the claims to the preferred embodiment with each burner under a separate hood, and excludes the alternate arrangement described in the patent in suit where a common hood is provided over several associated burners. This interpretation is obviously contrary to the language of the claims themselves. Claim 7 is specific to the alternate form of apparatus with the "associated burners" under a single baffle and also includes the burners as "independent fuel burning heating units." Quite obviously the definition of the heating units as "independent" was not intended to limit the claims to the preferred form of apparatus with a separate hood for each burner, but was intended merely to exclude the structure disclosed in the

patentee's earlier patent (Appellees' Appendix, 201) wherein *all* the burners are installed in a common flue.

The balance of respondents' brief is taken up with matters quite irrelevant to any issue presented here, such, for example, as the reference on page 2 to the prior suit by petitioners against the General Foundry & Machine Company.

This reference can have no other purpose here than to mislead this Court into believing that the questions presented by this petition are the same as those presented by the petition in the former case. Respondents fail to mention that the patent here in suit contains, in addition to the claims here in issue on the open flame curing system, a claim—claim 3—not here in suit, directed to an adaptation of the oil burners for heating the flues of the old-fashioned wood-burning flue system. That was the sole claim in issue in the General Foundry case. In that case the Court of Appeals of the Fourth Circuit held that the substance of the patentee's burner improvements was not embodied in the accused structure, and consequently there was no infringement, regardless of the breadth of the claim language. In this case the Court of Appeals of the Fourth Circuit has taken the opposite position and places a narrow interpretation on the claim language, to thereby exclude as an infringer one who has adopted the substance but not the form of the claimed invention.

Equally irrelevant is respondents' protest on page 5 of their brief that the Mayo apparatus was not copied from petitioners' Commercial Model D apparatus wherein the several associated burners are provided with a common hood. As both the preferred and alternate arrangements are fully described in the patent specification, it would seem to be immaterial whether or not this latter arrangement was on the market when the Mayo apparatus was introduced.

Also it is unimportant whether *all* the prior patents introduced in the Mayo-Hardy suit were offered by defendants in the case at bar. The so-called "important patent to Mims" (Appellant's App. 181), like the Brock and Rey-

nolds patents, shows nothing more than an oil heater in the middle of the barn.

The record in the Mayo-Hardy case is not here available, but it is plain from the opinions in the two cases that the Brock and Reynolds patents were in both cases chiefly relied upon as illustrative of the prior art, and that in the Mayo-Hardy case the second comer, Mayo, was accorded the status of a pioneer upon the mistaken belief that he was the first to successfully cure tobacco by the open flame method, while in this case the *earlier* patent to Smith, which describes and claims the apparatus which *did* solve that problem, is restricted in scope to the specific details shown and described.

It is therefore prayed that this petition be granted and the decision of the Court of Appeals for the Fourth Circuit reviewed and reversed.

Respectfully,

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Counsel for Petitioner.

New York, N. Y.,
November 15, 1950